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DENNISON, SCHEINER, SCHULTZ
& WAKEMAN
1745 Jefferson Davis Highway, Suite 612
Arlington, Virginia 22202-3417

In re Application of	:	DECISION ON
Jean-Paul MEAUSOONE et al	:	
PCT No.: PCT/FR99/02525	:	PETITION UNDER
Application No: 09/807,411	:	
Int. Filing Date: 18 October 1999	:	
Priority Date: 19 October 1998	:	37 CFR 1.47(a)
Attorney's Docket No.: 01065	:	
For: TUBE WITH MULTILAYER HEAD AND	:	
METHOD FOR MAKING SAME	:	

This is in response to the "PETITION UNDER 37 CFR 1.47 INCLUDING STATEMENT OF FACTS SHOWING DILIGENT EFFORT TO CONTACT A NON-SIGNING INVENTOR" filed on 09 October 2001, which is being treated as a petition under 37 CFR 1.47(a). The \$130.00 petition fee has been paid by credit card.

BACKGROUND

On 18 October 1999, applicants filed international application PCT/FR99/02525, which claimed priority of an earlier French application filed 19 October 1998. A DEMAND was filed on 12 April 2000 prior to the expiration of 19 months from the priority date electing the United States. Accordingly, the thirty-month (30) time period for paying the basic national fee in the United States of America expired at midnight on 19 April 2001.

On 19 April 2001, applicants filed for entry into the national stage in the United States of America. Filed with the application was, *inter alia*, the requisite basic national fee. No executed oath or declaration from the inventors accompanied the application at such time. A copy of the intentional application was transmitted on 27 April 2000 to the USPTO from the International Bureau.

On 14 August 2001, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, *inter alia*, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date" must be submitted within two months from its 14 August 2001 date of

mailing or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 09 October 2001, petitioner filed the present petition accompanied, *inter alia*, an executed Declaration without the signature of one of the three inventors, *i.e.*, without the signature of Roger La-Palus.

On 16 January 2002, the United States Designated/Elected Office erroneously mailed a Notification of Acceptance (Form PCT/DO/EO/903) since at the time of mailing the instant petition under 37 CFR 1.47(a) had not been reviewed and granted by the Office.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

REFUSAL TO JOIN:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the **37 CFR 1.47** applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See **MPEP § 106**. It is reasonable to require that the inventor be presented with the application papers before a petition under **37 CFR 1.47** is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the **37 CFR 1.47** applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied requirements (1), (3), and (4) of 37 CFR 1.47(a). However, requirement (2) has not been satisfied.

In this case, it has not been sufficiently demonstrated that a copy of the application papers were presented to the nonsigning inventor. Petitioner asserts that the documents were sent to him on March 27, 2001 by Ms. Montillot. The documents forwarded to Mr. La-Palus, however, did not appear to include a copy of the application papers (specification, including claims, drawings, and oath or declaration) as required under MPEP. 409.03(d). In addition, no documentary evidence to support this assertion has been provided such as a registered returned envelope, a certified mail return receipt, etc..., to show that the letters were sent to Mr. La-Palus. Consequently, it is unclear if he actually received the documents.

Furthermore, although petitioner has filed a statement by Ms. France attesting to the discussion with Mr. La-Palus, the statements do not detail the time and place of the call as required when there is a verbal refusal.

Consequently, the current record does not sufficiently establish Mr. La-Palus's refusal to join in the application because no evidentiary documents have been submitted to show that a *bona fide* attempt was made to deliver the complete application to Mr. La-Palus and that he refused to sign the required papers.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice. The Notification of Acceptance (Form PCT/DO/EO/903) mailed on 16 January 2002 is **VACATED** with the mailing of this decision.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a). Failure to timely file the proper response will result in **ABANDONMENT**.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


Rafael Bacares
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 308-6312
Facsimile: (703) 308-6459


Boris Milef
PCT Legal Examiner
PCT Legal Office